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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/975,698	10/10/2001	Peter J. Honeyman	DWR:187270-2	9196

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EXAMINER

MICHENER, JENNIFER KOLB

ART UNIT PAPER NUMBER

1762

DATE MAILED: 12/18/2002

2

Please find below and/or attached an Office communication concerning this application or proceeding.

As2

Office Action Summary

Application No.

09/975,698

Applicant(s)

HONEYMAN, PETER J.

Examiner

Jennifer Kolb Michener

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 10 October 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) 15-18 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-14 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s) _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 1 6) ☐ Other:

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-14, drawn to a method of preserving plant tissue, classified in class 427, subclass 4.
 - II. Claims 15-18, drawn to preserved plant tissue, classified in class 428, subclass 22.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case the product as claimed can be made by another and materially different process, such as using a dehydration process without subsequent saturation. Alternatively, the process can be used to make a materially different product, such as a preserved human body part.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

Art Unit: 1762

4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

6. During a telephone conversation with Karen Oster on 9/13/2002 a provisional election was made with traverse to prosecute the invention of Group I, claims 1-14. Affirmation of this election must be made by applicant in replying to this Office action. Claims 15-18 withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 8-10 and 13 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The phrase "rubber like" in claim 8, step (c), is indefinite because the claim(s) include(s) elements not actually disclosed (those encompassed by "like"), thereby rendering the scope of the claim(s) unascertainable. See MPEP § 2173.05(d).

Art Unit: 1762

Claims 9 and 13 make use of registered trademarks. The recitation of Trademarks renders the claim indefinite because it does not indicate whether the same material made under a different Trademarked product is equally operational. Moreover, the value of the Trademark is lost to the extent that it becomes descriptive of a product rather than the identification of a source or an origin of a product.

Claim 9, step (h) is indefinite because the claim is inclusive of combinations not actually disclosed.

It is not clear whether claims 8, 9, and 10 are directed to the compositions of the saturation mix, the coating mix, or both. Must both the saturation and coating mix contain at least one of the mixes a-d? Or is one of mixes a-d required only for one of the composition and coating mixes? The phrase "wherein said saturation mix and said coating mix are composed of at least one mix" is confusing. This language implies that one mix may be used instead of two, or that both the saturation and coating mixes are the same, or that only one is defined by the claim, but the other is still unspecified by the claim. For the purposes of examination, Examiner has interpreted the claim to be inclusive of all three of these scenarios.

Examiner notes that if part (a), (b), or (c) is selected in claim 8, then claim 9 is irrelevant because claim 9 only pertains to step (d) of claim 8. The same applies to claim 10.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 1-4 and 6-14 are rejected under 35 U.S.C. 102(b) as being anticipated by Fessenden (US 2,658,836).

Fessenden teaches a method of preserving a plant tissue by dehydrating a plant tissue and saturating said plant tissue with a saturation mix (col. 1, line 21; col. 2, line 37; col. 10, line 45). The saturation mix of Fessenden is an impregnation mixture (col. 10, line 16; col. 11, line 6). Fessenden teaches that by "impregnation" he means "saturation" (col. 4, lines 17), therefore, the impregnation mixture of Fessenden acts as the saturation mixture of Applicant in claim 1.

Regarding claim 2, Fessenden teaches the application of an enveloping mixture to said saturated plant tissue. Fessenden's enveloping mixture acts as Applicant's "coating mix" (col. 11, lines 24).

Regarding claim 3, Fessenden teaches a dehydration step. Fessenden must inherently "obtain" a plant tissue to dehydrate it. The dehydration step of Fessenden is said to fix and dehydrate the plant material (col. 2, line 37; col. 7, line 1).

Art Unit: 1762

Regarding claim 4, the dehydrating step of Fessenden is chemical-based (col. 4, line 36).

Regarding claim 6, Fessenden teaches that the saturating solution contains a solvent and that, after saturation/impregnation, the plant may be used for practical purposes without further processing. It is Examiner's position that after a plant tissue is saturated with a solution containing a volatile solvent, the plant tissue is inherently removed from said mixture, at which point the saturation mix will "drain" from the plant tissue. Due to the volatile solvent vehicle used, the plant tissue will inherently "dry" as the solvent evaporates. See also Example 1, lines 13-21. The same logic applies to the coating mix solution of claim 7.

Regarding claim 8, the saturation mix of Fessenden is taught to be selected from a number of substances used alone, or in combination, in solvent. One such substance is natural rubber (col. 11, line 1), as required by part (b). Since part (d) is not selected from the Markush group of claim 8, the chemical requirements of claims 9-10, which further define part (d), are not pertinent to Fessenden's selected composition. Claims 9 and 10 do not require selection of part (d) of claim 8.

Regarding claims 11-13, Fessenden does not specifically teach the words "polishing mix", however, it is noted that in Example 1, Fessenden teaches five coatings of the saturation mix to the plant tissue, with drying in between each layer. Any one of the

Art Unit: 1762

coating layers applied after the first application would qualify as a "polish" coating, as required by the claims. The saturation mix of Fessenden may be a combination of polystyrene and an organic silicon resin compound (col. 11, line 73, col. 11, line 75; col. 12, line 1; col. 12, line 46), qualifying as applicant's resin mix of silicone and styrene.

All of the limitations of claim 14 have been addressed above, with the exception of a "cleaning" step. It is Examiner's position that Fessenden inherently allows for cleaning to occur after dehydration because the removal of the tissue from the dehydrating chemicals will remove such chemicals from the plant.

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

12. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Fessenden in view of Waszkiewicz (US 3,563,780).

Fessenden teaches that which is disclosed above, including a dehydrating step.

Fessenden details a chemical dehydrating method, but also states that his method of saturation, etc. may be performed on a previously dehydrated plant material (col. 4, line 36) and that dehydration may be performed according to any well known procedure (col. 9, line 61). Fessenden fails to teach cleaning the dehydrated plant material by vibrating.

Art Unit: 1762

Waszkiewicz teaches a method of preserving flowers by drying using the burying method (such as the one required by claim 4 (a) of Applicant). When this method of dehydrating is used, Waszkiewicz teaches that the flower must be carefully removed from a dry silica gel powder and then shaken to remove any powdered material retained by it.

Since Fessenden teaches a dehydrating step that is inclusive of other procedures well-known in the art and Waszkiewicz teaches the well-known burying method for dehydrating, Waszkiewicz would have reasonably suggested the use of the burying method, and subsequent shaking step, in the method of Fessenden. It would have been obvious to one of ordinary skill in the art to use the teachings of Waszkiewicz in the method of Fessenden to provide Fessenden with an alternate means of dehydrating fresh flower material. It would have been expected by one of ordinary skill in the art that chemical means and burying means for dehydrating flowers are interchangeable with the expectation of similar results because both methods are known as successful methods throughout the art.

When the burying method of Waszkiewicz is used, his shaking step is used to clean the flower, meeting Applicant's limitation of "vibrating" in claim 5 (a).

13. Claims 8-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Fessenden in view of Romero-Sierra et al. (US 4,272,571).

Regarding the composition of the saturation mix or the coating mix, as required by claim 8, Examiner notes that Fessenden teaches that which is disclosed above. Specifically

Art Unit: 1762

Fessenden teaches that his enveloping mixture (acting as the coating mix of Applicant) may be made from a combination of polymers, such as polystyrene and organic silicon resinous compounds, as outlined above. Furthermore, Fessenden teaches that when multiple polymers are used together, they are polymerized together using catalysts (col. 12, lines 15-25). It is Examiner's position that such a polymerization step will create copolymers of the polymers used.

What Fessenden fails to specifically teach is the use of dimethylsiloxane with the polystyrene. However, the broad group of "organic silicon resinous compounds" taught by Fessenden is inclusive of polydimethylsiloxane. It would have been obvious to one of ordinary skill in the art to select a specific member of this broad silicon class for use in Fessenden's method.

Examiner cites Romero-Sierra for teaching the use of polydimethyl siloxane for preserving flowers (col. 4, lines 50).

Since Fessenden teaches organic silicon resinous compounds and Romero-Sierra teaches a specific organic silicon-containing resin, namely polydimethyl siloxane, Romero-Sierra would have reasonably suggested the use of polydimethyl siloxane as the organic silicon-containing resin of Fessenden. It would have been obvious to one of ordinary skill in the art to use the teachings of Romero-Sierra in the method of Fessenden to provide Fessenden with a specific, suitable polymer useful as the organic silicon-based resin.

When this particular siloxane is polymerized with styrene, the copolymer of claims 9 (a) is created.

Art Unit: 1762

Further, Romero-Sierra teaches the use of xylene solvent as compatible with the specific siloxane to be used in Fessenden's method, as required by claim 10 (b).

Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Rovetti is cited for teaching the use of wax on dehydrated plant materials. Wax would act as a polish.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jennifer Kolb Michener whose telephone number is 703-306-5462. The examiner can normally be reached on Monday through Thursday and alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on 703-308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.



Jennifer Kolb Michener
December 15, 2002



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